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FEB 16 2005

OFFICE OF PETITIONS

In re Application of
Nayyar
Application No. 09/880,169
Filed: June 13, 2001
Attorney Docket No. 372447-00101
For: MULTIMEDIA COMPRESSION/
DECOMPRESSION AND COMPRESSED
DATA REPRESENTATION

This is a decision on the petition, filed August 30, 2004 (certificate of mailing date August 25, 2004), under 37 CFR 1.183 requesting waiver of an extension of time fee paid under 37 CFR 1.136(a).

Pursuant to petitioner's authorization, deposit account no. 50-2778 will be charged the required \$130.00 petition fee owed.

The petition under 37 CFR 1.183 is DISMISSED.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.183 to waive 37 CFR 1.136(a)."

Petitioner states that the Examiner made an error in enumerating the claims of invention group II in the Office action dated June 25, 2004. The Office action set a 1 month extendable period for reply. Petitioner allegedly contacted the Examiner a number of times after receiving the flawed Office action and requested that the Examiner correct the error and mail a new Office action with a new period for response. The error in the June 25, 2004 Office action is obvious because the Examiner grouped claims 1-10 and 27-28 and there were only claims 1-14 in the application. The Examiner did not correct this error and did not set a new period for response. Petitioner filed an election and a 1 month extension of time and required fee on August 30, 2004 (certificate of mailing date August 25, 2004).

The June 25, 2004 set an extendable one month period for reply. Petitioner waited for another Office action instead of responding in writing to the June 25, 2004 Office action prior to July 25, 2004. Petitioner could have taken action within the one month period for reply and avoided having to pay an extension of time fee to continue prosecution. The extension of time fee was properly owed when paid.

Petitioner is advised that the statutory basis for 37 CFR 1.136(a) is 35 U.S.C. 41(a)(8)(A). 35 U.S.C. 41(a)(8)(A) states in pertinent part, "...The Director shall charge the following fees:... [f]or petitions for 1-month extensions of time to take actions required by the Director in an application... on filing a first petition..." The word "shall" appears in 35 USC 41(a)(8)(A). It is well settled that the use of "shall" in a statute is the language of command, and where the directions of a statute are mandatory, then strict compliance with the statutory terms is essential. Farrel Corp. v. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). The Office has no discretion in this situation.

The application is being returned to Technology Center G.A.U. 2621 to await reply to the December 28, 2004 non-final Office action.

Telephone inquiries pertaining to this decision may be directed to the undersigned at (571) 272-3230.



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